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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,583	10/30/2003	William J. Farrell JR.	548.0001	7235
25534	7590	01/25/2008		
CAHN & SAMUELS LLP 1100 17th STREET NW SUITE 401 WASHINGTON, DC 20036			EXAMINER GILBERT, WILLIAM V	
			ART UNIT	PAPER NUMBER
			3635	
			MAIL DATE	DELIVERY MODE
			01/25/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/696,583	<b>Applicant(s)</b> FARRELL ET AL.	
	<b>Examiner</b> William V. Gilbert	<b>Art Unit</b> 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-10 and 12-20 is/are pending in the application.
- 4a) Of the above claim(s) 14-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-10, 12, 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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#### **DETAILED ACTION**

This is a First Action on the Merits addressing the response dated 29 October 2007. Claims 1-6, 8-10, 12-20 is/are pending. Claims 7 and 11 is/are cancelled. Claims 14-20 is/are withdrawn from consideration. Claims 1-6, 8-10, 12 and 13 is/are examined.

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 29 October 2007 has been entered.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

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art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-6, 8, 10, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (U.S. Patent No. 4,611,450) in view of Sacks (U.S. Patent No. 6,820,387).

Claim 1: Chen discloses a construction panel (Fig. 2-3) having an outer and inner wire mesh member (223, located on both sides of the panel) that are screeds, and a middle member (Fig. 1: 10, 14, 16 and 18) disposed between the outer and inner mesh members and positioned to define a first gap (see Fig. 1, space between the middle member and mesh member) between the middle member and outer member and a second gap (opposing side) between the middle member and the inner mesh member. Chen does not specifically disclose the screed having at least two outwardly

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projecting screed ridges extending a length of the outer wire mesh member. Sacks discloses a construction panel (Fig. 7: 36), having a screed member (Fig. 6) defining at least two outwardly projecting screed ridges (14) extending the length of an outer wire mesh member. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the screed member in Sacks with the panel in Chen because the purpose of the screed member in Sacks is designed to reduce cracking in stucco (Abstract, line 10) and would perform adequately with the panel in Chen.

Claim 2: the phrase "adapted to accept a dowel for securing said panel" is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim 3: the middle member of Chen comprises a plurality of layers (Fig. 1: 10, 14, 16, 18) comprising wire trusses (211) and polystyrene foam (Abstract, line 11).

Claim 4: Chen in view of Sacks discloses the claimed invention including that the middle member (212) would be in a compressed state (which would occur when the stucco is applied),

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but the prior art of record does not disclose the compression is 2.5 inches. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to compress to this degree as a matter of design choice because Applicant did not state a criticality for the necessity of this limitation and the prior art of record is capable of being compressed in such a manner.

Claim 5: while the ridges in Chen in view of Sacks are V-shaped (see Figure 1, below for clarification), and have a depth of about  $\frac{1}{2}$  inch (Col. 7, lines 3 and 4), the specifics of the dimensions of the width of the panel. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have these dimensions because Applicant failed to state a criticality for the necessity of these limitations and the prior art of record is capable of conforming to the limitations.

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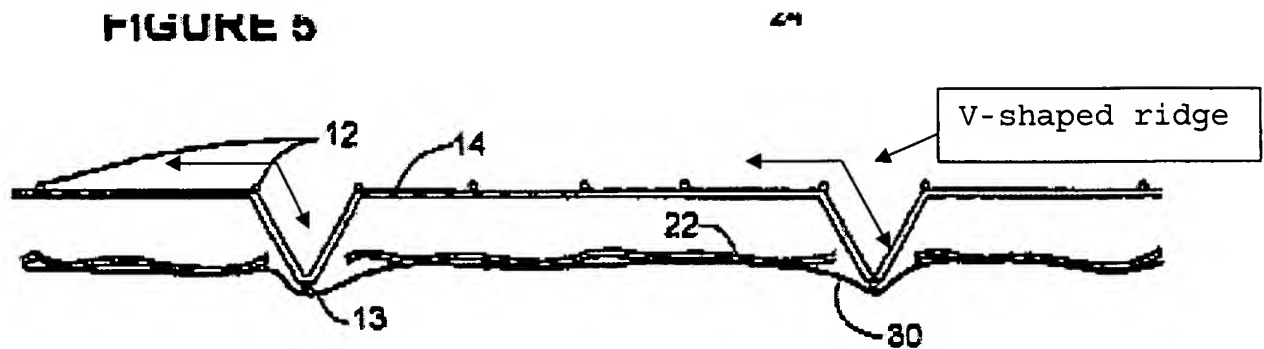


Figure 6 from Sacks

Claim 6: Chen in view of Sacks discloses 2 parallel V-Shaped impressions (see above) defined in at least the outer wire mesh member.

Claim 8: Chen discloses means for securing the wire mesh member to the middle member (by through the truss member (232))

Claim 10: Chen in view of Sacks discloses an outer layer (Chen: Claim 8), but not that the V-shaped impressions are used as a screed. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the V-shaped impressions (see above) as a screed in order to prevent the waste of stucco applied to the surface.

Claims 12 and 13: Chen in view of Sacks disclose the claimed invention except for the dimensions as claimed, though Sacks notes that any dimension may be created (Col. 7, lines 23-

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25). It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have these limitations because Applicant failed to state a criticality for the necessity of these dimensions and the prior art of record is capable of meeting these limitations.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Sacks as applied to claim 8 above, and further in view of Rockstead (U.S. Patent No. 4,104,842) and Salisbury (U.S. Patent No. 4,660,342).

Claim 9: Chen in view of Sacks discloses the claimed invention except for the use of hog rings and a Z-clip. Rockstead discloses a construction panel that uses hog rings (Col. 3, lines 41, 42) to attach to a wall system and Salisbury discloses the use of a Z-clip (Fig. 4: 49) in conjunction with a ring (50) to attach a panel to a wall. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the hog ring and Z-clip in conjunction with the panel in Chen in view of Sacks in order to securely attach the panel to another structural surface.



***Response to Arguments***

3. The following addresses applicant's remarks dated 27 August 2007.

**Drawing objections/claim objections/35 USC 112 rejections:**

Applicant's amendments as noted overcome the objections and they are therefore withdrawn.

**Claim rejections under 35 USC 103:**

The examiner respectfully disagrees with applicant's claim language addressing "at least two **outwardly** projecting screed ridges" [emphasis added]. The prior art as claimed denotes "two outwardly extending projecting screed ridges" as claimed (Sacks: 14, cited above). The examiner respectfully notes that the applicant does not provide further limitation as to what is projected outwardly: only a "ridge"; therefore, the examiner contends that portion Sacks element 14 is an outward projection. The applicant provides some limitation to the projection in claims 5 and 6 (the "V-shaped impression"). The examiner respectfully contends, however, that this limitation is very broad and that the prior art of record still discloses a "V-shaped impression" (see rejection above).

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*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571.272.6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. V. G./  
Examiner, Art Unit 3635

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mupkane* 1/19/08